

### **REMARKS/ARGUMENTS**

The amendments made to the specification correct typographical errors.

Applicant respectfully traverses the rejection of claims 1-3 under 35 U.S.C. § 101 as directed to nonstatutory subject matter. The Examiner maintains that the “patient record” recited in independent claim 1, though useful and concrete, is not tangible because “it appears that the patient record is not limited to any particular structural element.” (8/5/03 Office action at 3.) But the “patient record” recited in the claim 1 preamble comprises two clearly tangible elements: a “digital vital patient record” that exists in computer memory (or an equivalent medium) and a “hardcopy patient record” that exists on paper (or an equivalent medium). In short, the patient record is the sum of the digital VPR and the HCPR. (Of course, given the open-ended transition “comprising”, the patient record according to claim 1 may include other elements, but the patient record must include the tangible digital VPR and HCPR.) Therefore, claim 1, and dependent claims 2 and 3, are directed to statutory subject matter.

Applicant also respectfully traverses the rejection of claims 1-5, 7, 9-12, 14-16, and 18 under 35 U.S.C. § 103(a) as obvious over the Eberhardt '488 patent in view of the Garcia '315 patent.

The Eberhardt '488 patent discloses methods and systems for managing medical history information that includes using an electronic version of a complete patient medical history. This full electronic patient record is referred to in Eberhardt as “a stored record of the medical history of an individual (‘MH’).” (Eberhardt '488 patent at col. 1, lines 12-13; *see also* col. 6, lines 32-35.) Indeed, the teachings in Eberhardt are directed to allowing individuals to carry on their person a comprehensive MH. (*See, e.g.*, Eberhardt '488 patent at col. 3, lines 9-16; col 3, line 66 to col. 4, line 3; col. 4, lines 17-20.) Eberhardt also discloses using in conjunction with the MH file another data file: “the ‘Critical Information File (CIF), [which] contains critical medical information about the individual.” (Eberhardt '488 patent at col. 7, lines 54-56.) The CIF is a

second file stored on a storage device (SD 1) together with the MH file. (*See, e.g.*, Eberhardt '488 patent at col. 7, lines 49-55.)

The Garcia '315 patent describes systems and methods for scheduling and recording patient services that also store electronically complete patient medical histories. As Garcia teaches, "[i]n all instances [involving various hospital services], the reported [patient] information is stored in the memory of computer 26 . . . ." (Garcia '315 patent at col. 7, lines 50-52; *see also* col. 2, lines 29-41; col. 7, lines 35-42.)

In contrast to these prior-art references, the present invention teaches systems and methods for maintaining vital patient data without using a full electronic patient record or medical history. In fact, the concept of the full electronic patient record (EPR) is described in the Background section of the present application as providing some benefits over using a hardcopy patient record (HCPR) alone, but still exhibiting considerable problems of cost, complexity, and consistency. (Application at p. 5, lines 4-20.) The present invention thus discloses handling essential patient information without using a full electronic patient record. (*See, e.g.*, Application at p. 5, lines 22-23.) This is a plain distinction over Eberhardt and Garcia.

Although Applicant believes that the claims as originally submitted incorporated this distinction, to make this more clear independent claims 1, 4, 11, 15, and 19 are currently amended to recite specifically that the invention comprises a digital vital patient record "without using a full electronic patient record". Given that this express limitation is not taught by either the Eberhardt '488 patent or the Garcia '315 patent, for at least this reason those patents cannot be combined to render obvious claim 1 (or dependent claims 2-3), claim 4 (or dependent claims 5, 7, 9, and 10), claim 11 (or dependent claim 12), or claim 15 (or dependent claims 16 and 18).

Applicant further respectfully traverses the rejection of claims 6, 8, 13, and 17 under 35 U.S.C. § 103(a) as obvious over Eberhardt in view of Garcia, and further in view of the Sujansky article. As the Examiner explains, "Sujansky discloses a drug prescription assistance program

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integrated with an electronic medical records system to detect drug-drug and drug-allergy interactions based on prescription information and other clinical data (pg. 4, par. 2-3)." (8/5/03 Office action at 11.) But nothing in Sujansky suggests a system that includes a digital vital patient record without using a full electronic patient record, as explained above regarding the independent claims of the present application. Because Sujansky does not supply the teachings of the present invention missing from Eberhardt and Garcia, Sujansky cannot be combined with either or both of those references to render obvious dependent claims 6, 8, 13, and 17.

Applicant also respectfully traverses the rejection of claim 19 under 35 U.S.C. § 103(a) as obvious over Eberhardt in view of Garcia and Sujansky. As explained above, nothing in any of those three prior-art references discloses a method that includes a digital vital patient record without using a full electronic patient record. Thus claim 19, as currently amended, clearly distinguishes over Eberhardt in view of Garcia and Sujansky.

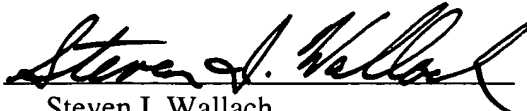
Applicant respectfully submits that no new matter is presented by the amendments made herein to the specification and claims, and that the application is in condition for allowance; a Notice to that effect is respectfully solicited.

No fee is believed to be due with this Amendment. A fee is enclosed with the Petition for Extension of Time. The Director is authorized to charge any fee deficiency, or credit any overpayment, regarding that Petition or this Amendment to Morrison Cohen Singer & Weinstein, LLP Deposit Account No. 502771. A duplicate of this sheet is enclosed.

Respectfully submitted,

**Morrison Cohen Singer & Weinstein, LLP**

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